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EXAMINER

PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/782,772	Applicant(s) KOVALES ET AL.	
	Examiner Joseph T. Phan	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-42,44-59 and 61-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-42, 44-59, 61-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/03/05 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ...*mark one or more segments of the voice mail message according to degrees of importance*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claims merely recite "...*mark one or more segments of the voice mail message as having one or more different degrees of importance*". As written, examiner can interpret the claims as in the alternative "...*mark one or more segments of the voice mail message as having one degree of importance*" which Hamel teaches in *col.3 lines 16-55, col.4 lines 55-67, and col.8 lines 35-67*. It is understood that marked segments are important to the caller if he/she bookmarks/interrupts the message.

It is noted that the phrase "different degree of importance" does not limit the claims to a specific degree(e.g. a 1-10 numbering system) and therefore Hamel's different/multiple number of segments inputted can read on having different degrees of importance(col.5 lines 24-48).

It is also noted that Hamel teaches providing multiple bookmarks/segments in a voicemail message by the caller (col.5 lines 14-48).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-10, 12-20, 22-38, 40-47, 49-59, 61-72, and 74-91 rejected under 35 U.S.C. 102(b) as being anticipated by Hamel, et al., Patent #5,943,402.

Regarding claims 1, 33, and 57, Hamel teaches a method, system and computer program product for providing at least one bookmark for a voice mail message by a caller leaving the voice mail message;

wherein at least one bookmark is used to mark one or more segments of the voice mail message as having one degree of importance(*col.3 lines 16-55 and col.4 lines 55-67, col.5 lines 34-48, and col.8 lines 35-67; it is important if it is interrupted/bookmarked*).

Regarding claims 2, 34, and 82 Hamel teaches a method, system and computer program product according to claims 1, 33, and 57 further comprising the step of creating a bookmarked message from the voice mail message and the at least one bookmark(*col.5 lines 16-48 and col.8 lines 35-67*)

Regarding claim 3, 35, and 58, Hamel teaches a method, system and computer program product according to claims 2, 34, and 82 further comprising the step of playing the bookmarked message to a listener (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claim 4, 36, and 59, Hamel teaches the method, system and computer program product according to claims 1, 33, and 57 wherein at least one bookmark segments the voice mail message according to one or more topics(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 6 and 61, Hamel teaches the method, system and computer program product according to Claims 1, 37, and 57 wherein a default degree of importance is associated with segments not otherwise marked (*col.8 lines 35-67; not important if it is not interrupted/bookmarked*).

Regarding claims 7, 37, and 62, Hamel teaches the method, system and computer program product according to claims 1, 33, and 57 wherein at least one bookmark corresponds to one or more special types of information in the voice mail message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 8-10, 38, 40, and 63-66 Hamel teaches the method, system and computer program product according to claims 7, 37, and 62 wherein at least one of the special types of information is one of a: callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; an email address; or a protection/confidentiality indicator (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67; it is understood that the originator can include any type of information in it*).

Regarding claim 67 Hamel teaches a computer program product according to claim 59 further comprising code configured to use the at least one bookmark to

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navigate from one topic of the voicemail to another(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claim 14, 41, and 68, Hamel teaches a method, system and computer program product according to claims 2, 34, and 58 further comprising the step of using the at least one bookmark to perform actions selectively on one or more segments of the voice mail message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67; listening to the segment is an action*).

Regarding claim 15, 42, and 69, Hamel teaches a method, system and computer program product according to claims 14, 41, and 68 wherein the selected segments are associated with a topic of the voice mail message(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67; the beginning of the voicemail message is a topic for the selected segments*).

Regarding claim 16, 43, and 70, Hamel teaches a method, system and computer program product according to claims 14, 41, and 68 wherein the selected segments have one or more different degrees of importance(*col.8 lines 35-67; it is important if it is interrupted/bookmarked*).

Regarding claims 17, 47, and 72 Hamel teaches a method, system and computer program product according to claims 14, 41 and 68, wherein the selected segments are associated with one or more special types of information in the voice mail message(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claim 18, 44, and 71, Hamel teaches a method, system and computer program product according to claims 14, 41, and 68, wherein the actions comprise one

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or more of saving, deleting, forwarding, listening, skipping, or repeating the one or more segments, and marking a particular segment as protected or confidential prior to forwarding the marked segment to another party (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67; listening to the segment is an action*).

Regarding claim 19 and 45 Hamel teaches a method, system and computer program product according to claims 18 and 44, wherein the actions further comprise marking a selected segment as protected or confidential(*col.8 lines 35-67; these actions by Hamel's users are protected and confidential since no one else can retrieve it*).

Regarding claim 20 and 46 Hamel teaches a method, system and computer program product according to claims 19 and 45 further comprising forwarding the segment marked as protected or confidential to another party (*col.8 lines 35-67; these actions by Hamel's users are protected and confidential since no one else can retrieve it*).

Regarding claim 22 Hamel teaches the method according to claim 2, wherein the creating step further comprises storing the bookmarks and the voice mail message separately as the bookmarked message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claim 23 Hamel teaches the method according to claim 2 wherein the creating step further comprises storing the bookmarks and the voice mail message intermingled as the bookmarked message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 24, 49, and 74 Hamel teaches a method, system and

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computer program product according to claims 3, 35, and 58, further comprising announcing for the bookmarked voice mail message, a number of the bookmarked segments in the voicemail message (*col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 25-26, 50, 75, 83-86 Hamel teaches a method, system and computer program product according to claims 1, 3, 7, 33, 35, 37, 58, 60, and 62 further comprising announcing, before, during, or after playing the voicemail message, the different degree of importance in the voice mail message and a number of segments thereof(*col.4 lines 55-66, col.5 lines 22-48, col.7 lines 1-8, and col.8 lines 35-67; the phrase "different degree of importance" does not limit the claims to a specific degree(e.g. a 1-10 numbering system) and therefore Hamel's different/multiple number of segments inputted can read on having a different degree of importance*).

Regarding claims 27, 51, 76, 87-88 Hamel teaches a method, system and computer program product according to claims 3, 5, 7, 35, 37, 43, 58, 60, and 62 further comprising announcing, before and after playing the voicemail message, the special types of information in the voicemail message(*col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 28, 52, and 77 Hamel teaches the method, system and computer program product according to claims 7, 37, and 62 wherein particular ones of the special types of information are required, and further comprising the step of prompting the caller to provide input for each particular one for which no bookmark is otherwise provided(*col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 29, 53, and 78 Hamel teaches the method, system and computer program product according to claims 2, 34, and 58 further comprising the step

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of associating one or more audio cues with one or more bookmarks of the voice mail message(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 30, 54, and 79 **Hamel** teaches the method, system and computer program product according to claims 29, 53, and 78 further comprising the steps of playing the bookmarked message to a listener; and incorporating the one or more associated audio cues along with respective portions of the voice mail message corresponding to the one or more bookmarks (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 31, 55, and 80 **Hamel** teaches the method, system and computer program product according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue with its respective portion of the voice mail message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 32, 56, and 81 **Hamel** teaches the method, system and computer program product according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue in-line with its respective portion of the voice mail message(*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Regarding claims 89-91 **Hamel** teaches a method, system and computer program product according to claims 1, 33, and 57 wherein the caller provides a plurality of bookmarks for the voice mail message (*col.3 lines 16-55, col.4 lines 55-67, col.5 lines 16-48, and col.8 lines 35-67*).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 21, 39, 48, and 73 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamel in view of Haddock, Patent #5742736.

Regarding claims 11, 21, 39, 48, and 73 Hamel teaches a method, system and computer program product according to claims 17, 37, 47, and 72.

Hamel is silent on wherein at least one of the special types of information comprises a uniform resource locator(URL) and where at least one of the actions comprises automatically establishing a connection to the URL.

Haddock teaches viewing and manipulating voice mail messages on a computer display and the contents thereof can be retrieved and connected to applications on the computer (col.4 lines 38-54).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include a computer display like in Haddock to view and access information within voice mail messages as taught in Hamel(col.1 lines 45-52).

One of ordinary skill in the art would have been motivated to do this as automatically connecting to a URL via a displayed hyperlink is old and well-known in the art and since Haddock's user is able to use information(e.g. phone #, points of interest,

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etc.) to automatically establish a connection to it, URL's are just an example of points of interest that can be accessed with a computer application(e.g. "Internet Explorer").

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **Kuter et al., Patent #6,876,729** teaches bookmarking voice messages and selecting the segment of the bookmark.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP

December 20, 2005

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